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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,179	10/23/2003	Nael A. Al-Abdulla	58443 (71699)	2620
21874 7590 05/20/2008 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205				
EXAMINER KIDWELL, MICHELE M				
ART UNIT		PAPER NUMBER		
3761				
MAIL DATE		DELIVERY MODE		
05/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/693,179

Applicant(s)

AL-ABDULLA ET AL.

Examiner

Michele Kidwell

Art Unit

3761

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-17,19-49 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-17,19-49 and 51-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2008 has been entered.

Claim Objections

Claim 2 is objected to because of the following informalities: line 6 of the claim recites the term "mechanism" twice. One occurrence should be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, 7 – 11, 19 – 49 and 51 – 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (US 4,175,704).

With respect to claim 1, Cohen discloses a device for the delivery of a substance to the eye comprising: a housing (12) for holding the substance and a non-aerosol, non-electric (abstract) delivery mechanism comprising a tubular member (20) disposed within the housing, an actuation mechanism (30) positioned at the top of the housing, and at least one outlet port (34) in the actuation mechanism in communication with the tubular member, wherein the delivery mechanism is configured such that substance is delivered from the housing, through the tubular member, through the outlet port, and ,delivered to the eye in the form of a spray or mist as set forth in col. 2, lines 25 – 60 and in the figures.

Regarding claim 2, Cohen discloses a device for the delivery of an artificial tears or demulcent composition to the eye comprising: a housing (12) for holding the substance and a non-aerosol, non-electric (abstract) delivery mechanism comprising a tubular member (20) disposed within the housing, an actuation mechanism (30) positioned at the top of the housing, and at least one outlet port (34) in the actuation mechanism in communication with the tubular member, wherein the delivery mechanism is configured such that substance is delivered from the housing, through the tubular member, through the outlet port, and ,delivered to the eye in the form of a spray or mist as set forth in col. 2, lines 25 – 60 and in the figures.

With reference to claim 3, Cohen discloses a device wherein the force of the spray or mist is sufficient to deliver the spray or mist to the eye without the aid of gravity as set forth in col. 2, lines 61 – 68. The examiner contends that the force is

directly related to the amount of pressure applied and may be sufficient to deliver to deliver the spray or mist without the aid of gravity.

With respect to claim 4, Cohen discloses a device wherein the spray is delivered to the eye in a substantially horizontal direction as set forth in figures 2 and 4.

As to claim 5, Cohen discloses a device wherein the housing is hollow and the substance is contained within the hollow of the housing as set forth in figure 4.

Regarding claim 7, Cohen discloses a device wherein the housing contains a reservoir that holds the substance as set forth in figures 2 and 4.

As to claims 8 and 9, Cohen discloses a device wherein the housing is fabricated of a rigid material, which would be of sufficient thickness to prevent collapse of the housing during use, as set forth in col. 2, lines 11 – 16.

With respect to claim 10, see col. 2, lines 11 - 12.

With reference to claim 11, Cohen discloses a device wherein the housing is cylindrical in shape as set forth in figure 2.

Regarding claims 19 and 20, Cohen discloses a device wherein the actuation mechanism is movable with respect to the housing in order to deliver the substance to the eye as set forth in col. 3, lines 10 – 17. The examiner contends that the manner by which the actuation mechanism is moved is considered a product-by-process limitation that does not patentably distinguish the claimed invention from the prior art.

As to claim 21, Cohen discloses a device wherein the actuation mechanism includes a spray nozzle (34) as set forth in figure 2.

With reference to claims 22 – 23, see the rejection of claims 19 – 21.

Regarding claims 24 – 27, see the abstract.

As to claims 28 – 29 and 32, the examiner contends that Cohen discloses the invention as claimed.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The invention of Burke is fully capable of performing the recited function.

As to claim 30, see col. 2, lines 61 – 68.

Regarding claim 31, see col. 3, lines 10 – 17.

With reference to claim 33, Burke discloses a device further comprising an extension (60) substantially or completely surrounding the outlet port and extending in the direction that the spray or mist is delivered wherein the extension assists in directing the substance to the eye and assists in preventing the substance from being delivered to areas outside of the eye as set forth in figures 7 – 8.

As to claim 34, see the rejection of claim 3.

As to claim 35, see the rejection of claim 2.

As to claims 36 and 37, see the abstract.

As to claim 38, see the rejection of claim 4.

With reference to claims 39 – 41, see the rejection of claims 19 – 20.

As to claim 42, see col. 3, lines 10 – 17 and the abstract.

With reference to claim 43, see the rejection of claim 27.

With reference to claims 44 – 47, see the rejection of claims 28 – 29 and 32.

As to claim 48, see col. 6, lines 33 – 45.

Regarding claim 49, see the rejection of claims 1 and 2.

As to claims 51 and 52, the examiner contends that any device may be considered reusable and/or disposable.

With reference to claims 53 – 56, see col. 3, lines 51 – 54.

As to claim 57, see the rejection of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen (US 4,175,704).

The difference between Cohen and claims 12 – 17 is the provision that the housing has specific dimensions.

It would have been obvious to one of ordinary skill in the art to modify the dimensions of Burke to determine the most effective product since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum value involves only a level of ordinary skill in the art.

Response to Arguments

Applicant's arguments with respect to claims 1 – 5, 7 – 17, 19 – 49 and 51 – 57 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Michele Kidwell/

Primary Examiner, Art Unit 3761